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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/329,668	06/10/1999	PETER J. WILK	W07-424	8390

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EXAMINER
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PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/329,668

Applicant(s)

WILK, PETER J.

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,12,13,15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3-9,12,13,15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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#### **DETAILED ACTION**

1. In view of the appeal brief filed on 11/13/03, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

2. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

#### ***Status of the Application***

3. Claims 1,3-9,12,13,15 and 17 are currently pending of which claims 1 and are independent claims. Claims have been amended per amendment B filed 3/17/03 (Paper #5)

4. The examiner has clarified certain issues raised by the applicant in previously submitted Amendment filed 3/24/03. The claim analysis has been changed and rewritten to address the issues of communication with the RCT host and cyber-securities providing the teachings of operating a host computer to carry-out process of offering units of equity in the technology development ventures.

#### ***Response to Arguments***

5. Applicant's argument that there is nothing in the RCT reference which indicates that technology disclosures are sent over the Internet to the host computer is not convincing. To

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begin with, the claims do not recite the Internet as a global communication network in any of the subject claims.

6. RCT is described as defining the state of the art in technology transfer (p. 1) where RCT web address is indicated as www.rtech.com. Furthermore, the contact information is not just limited to telephone or ordinary mail. It has been customary, well before, the claimed invention for businesses and individuals to communicate via an electronic mail as indicated explicitly in the RCT reference. (Refer to a Part of RCT reference "How to Contact RCT" now submitted with this office action) It is therefore, clear and obvious to one of ordinary skill art that technologies for commercial potential can be sent to the RCT host computer over a network using the E-Mail Contact indicated on the RCT web page.

7. Applicant has amended claim 8 so as to incorporate in it limitations of claims 10 and 11 (alternatively, 14 and 16). The only argument forwarded by the applicant in support of the amended claim 8 is that the primary reference, RCT fails to teach or suggest the transmission of technology over the Internet. This argument has been already addressed in detail in response of claim 1 arguments as discussed above.

8. In regards to the Cyber-securities disclosing the business method of enhancing investment in new technologies the examiner

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would like to point out that first part of claim 1 pertains to offering "equity shares" in the purported new technology venture to a predetermined number of potential investors. In case of Internet based IPO (Initial Public Offering) as disclosed by Cyber-securities the steps involved in IPO are performed over a "Global Communication Network" which is the Internet. Bids are orders received from prospective investors to purchase the shares of "public" offering. Since, IPO involves receiving bids for the IPO shares (of a technology development venture) and since it involves customary book-keeping including recordation of number of shares allocated to each selected investors and since each IPO involve a predefined number of shares (number of units bid) the requisite steps of claim 8 are inherent to the Cyber-securities reference. Note that RCT is combined with Cyber-securities because RCT does not explicitly recite offering units of the technology development venture in the form of an IPO over a communication network.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

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subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over RCT's Tips for Investors (RCT) and further in view of "The Internet and the Cyber-securities Marketplace" (Cyber-securities).

Claim 1. RCT discloses a method for facilitating financing of new technology, comprising:

maintaining a host computer connected to a global computer network for receiving, over said network from remote computers, information describing purported advances in technology;

(refer to page

RCT "How to Contact RCT" a host computer which hosts the web site rcotech.com is maintained, since this computer is connected to the internet and can receive information describing purported advances in technology via the Internet, for example, using the E-mail contact such as "mccoy@rcotech.com")

accessing said host computer to obtain said information;

(RCT "How to Contact RCT" para 4 the host computer (rcotech.com) to which the e-mail is addressed, e.g.

"mccoy@rcotech.com" receives the information sent as explained above, since members of "academe and industry" may submit the information to the host computer accessible by the appropriate

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member of RCT staff (p.4 "The scientists, engineers and chemists in our ...Groups.." "...appraise technologies sent to RCT for commercial potential...);

performing an evaluation of said advances in technology to determine, for each of said advances, a fixed monetary amount to be contributed in exchange for a unit of equity in a prospective technology development venture to develop the respective one of said advances (p. 1 para 5 Venture Development and financing plans...financing plans for adding value to early stage development which also include offering equity share in the technology venture);

RCT fails to explicitly teach the limitation of transmitting identifications of said advances together with respective values of the determined fixed monetary amounts over the global computer network as per claim 1.

Cyber-securities, in the same field of endeavor, however, teaches a method for facilitating financing of new technology. Cyber-securities teaches transmitting identifications of advances in technologies to preselected computers (description of the offering such as profile of the corporation whose securities are offered in the public offering) together with respective values of the monetary amounts (offering price on a per share base) over a global communication network (refer to section 2. Underwritten Offerings Over the Internet, "an

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Internet site for the Initial Public Offering of ..stock", also refer to section 3 conducting "Roadshows" over the Internet which further recites transmitting of the information in the form of "road shows" over the Internet to preselected investors (large investors) and

Operating a host computer to receive, over the network from ..preselected computers, respective bids for desired number of units of equity in the technology development ventures (refer to section 2 paragraph "The same year.. which provided opportunities for investing in underwritten IPO's on its web site ([www.witcapital.com](http://www.witcapital.com))).

Cyber-securities, therefore teaches both transmitting identification of advances with respective values of the determined fixed values and operating said computer ...respective bids for desired number of units of equity in the technology development ventures as recited (an inherent process step of public offering of securities which is subject of the reference).

It would have been obvious to one of ordinary skill in the art at time of the invention to implement the transmitting of identification of the advances together with respective values of the determined fixed monetary amounts as disclosed by the Cyber-securities article into the RCT reference so as to



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develop a method for facilitating financing of new technology as per claim 1 because the resulting method would facilitate communication of the technology advances together with their respective values of fixed monetary amounts to a large potential and interested investors without regards to any geographic or time limitations and would contribute to a more open, efficient and democratic financing of the new technology for which the financing is sought. It would also allow a single entity (such as RCT) to carryout appraisal of the technologies received at the host for venture development and carryout financing of the technologies by offering to the suitable investors over a global communication network. (other benefits of such combined method are described throughout both references).

Claim 7. The method defined in claim 1 wherein the transmitting of said identifications and the respective values of the determined fixed monetary amounts is undertaken via said host computer (the RCT is implemented on a web host and determination of fixed monetary amounts is undertaken by RCT, para 5 p.1).

11. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over RCT and Cyber-securities references as applied to claim 1 above, and further in view of article "Revolution or Evolution? W.R. Hambrecht & Co. Brings underwriting to the

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Internet", The IPO Reporter, v 23, n 7, p4, Feb 1999 (hereafter the IPO Reporter).

Claims 3-5: the RCT or Cyber-securities references fail to explicitly recite, "setting a maximum number of units of equity", "automatically tally totals of units" and "transmit a bidding termination signal" are routine and customary steps in IPO process.

The limitations recited in the subject claims refer to customary steps performed in trading and/or IPO offering by an entity such as a market maker or a managing firm of an IPO. Thus, the recited claim limitations are within the scope of references cited above because these procedural steps are required and anticipated in conducting of an on-line financing of new ventures or IPOs as discussed in the IPO reporter reference as an example. In this regard official notice is taken that setting a maximum number of units of equity, automatically tally total of units, transmitting bidding termination signals (as per recitation in claim 3), automatically advise the preselected computers (i.e. bidders) (claim 4), automatically record identities of preselected each computers (claim 5) are old and well known and anticipated in the art of trading of financing instruments including IPOs and therefore it would have

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been obvious to one of ordinary skill in the art at the time of the invention to incorporate these steps in the method for facilitating financing of new technologies as discussed in claim 2 analysis because this implementations would lead to a financing of new technologies (ventures) which would conform to the existing market and regulatory requirements, which would facilitate required communication of bidding status to the bidder and ultimately lead to more open, efficient and democratic financing of the new technologies.

12. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over RCT and further in view of Cyber-securities as applied to claim 1 and further in view of McNabb (US Pat. 6,289,462).

As per analysis of claim 1, RCT and Cyber-securities references while teach all limitations of claim 1, do not teach that identifications and respective values are transmitted in encrypted form. McNabb, in the same field of endeavor, however, teaches a method of providing security as applied to communication of data pertaining to financial transactions (McNabb col. 2 L 36-47).

It would have been obvious to one of ordinary skill in the art at the time of invention to have the identification and the

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respective values transmitted in encrypted form because encryption of identification and the respective values would provide a measure of security from unauthorized access and thus would help maintain confidentiality of the transmitted data.

13. Claims 8-9, 12,13, 15 and 17 are rejected under 35

U.S.C. 103(a) as being unpatentable over Cyber-securities and further in view of RCT.

Per claim 8,RCT teaches a business method for enhancing investment in new technologies wherein a host computer (RCT web site) monitors information arriving over said global computer network (the Internet, see claim 1 analysis), said information describing purported advances in technology, further comprising selecting said prospective technology development venture from among the purported advances in technology described in the information arriving over said global computer network (appraise technologies sent to RCT ... , p.1, and How does RCT Appraise Technologies? further teach appraisal of technologies sent to RCT by inventors. Since only some of the technologies meet the criteria for its commercialization...) (further analysis of limitation "operating said host computer ..arriving over ..global computer network" is provided in discussion of claim 1 above.).

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RCT fails to explicitly disclose steps of "selecting ..potential investors", "transmitting ..investment opportunities each comprising an identification of purportedly new technology and fixed monetary amount to be exchanged..", "receiving bids for units of equity..monitoring messages arriving a global computer network", "recording identities..", "automatically tallying...: and "terminating bidding ..". Cyber-securities, in the same field of endeavor, however, teaches a business method for enhancing investment in new technologies (IPOs), comprising:

Selecting a predetermined number of potential investors (refer to section 3. Conducting "Roadshows", presentations are made to large investors ...etc., this is disclosed throughout the discussion of conducting of "Roadshows");

transmitting, to potential investors, investment opportunities each comprising an identification of purportedly new technology (Beginning in 1997, the SEC opened the door for underwriters and issuers to conduct "road shows" over the Internet", section 3. discussion of conducting of "Road shows") and a fixed monetary amount to be exchanged in return for a predetermined unit of equity (IPO comprises price of offering in terms of amount per share) in a prospective technology development venture to develop the respective technology. Also "presentations" made by the issuer constitute investment

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opportunities, other elements of the limitations are fixed monetary amount to be exchanged for a predetermined unit of equity.. is discussed in the preceding paragraphs);

Cyber-securities further inherently teaches receiving bids..from at least some of the investors, ..including operating a host computer to monitor messages.. (iv) recording identities of the bidding investors and the number of units of equity bid (v) automatically tallying total units bid and (vi) terminating bidding upon attainment of a predetermined number of units bids as recited in the subject claim because these steps are customary steps of IPO conducted over a communication network such as the Internet and suggested in Cybersecurities (refer to "Underwritten Offerings Over the Internet").

Furthermore, Official notice is taken that receiving bids for units of equity from investors over a global computer network, recording identities of the bidding investors and the number of units of equity bid; automatically tally units of bid, and terminating bidding upon attainment of a preselected number of units sold are old and well known, required and anticipated in the art of trading of financing instruments including IPOs. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine steps disclosed in RCT which include operating a host computer to monitor information

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arriving over a global communication network and selecting a prospective technology venture development with steps of offering the selected prospective development venture in the form units of equity to a predetermined number of potential investors in a manner disclosed by Cyber-securities into the RCT host computer because this combination would facilitate development and financing of new technologies ventures more efficiently consistent with the prevailing financial markets regulatory requirements.

Claim 9: RCT fails to teach, however, Cyber-securities teaches respective identification and the respective fixed monetary amount over a global computer network (the Internet) are transmitted to potential investors using a host computer (Cyber-securities : Road shows include prospectus for the underwritten new technologies, and is presented over the Internet).

For motivation of combining RCT and Cyber-securities please refer to claim 8 analysis.

Claims 12. wherein the automatic tallying of the total units bid includes operating said host computer to add units bid

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by respective ones of said bidding investors (refer to analysis of claim 8).

Claim 13. transmitting of termination signal to the preselected computers (refer to Cyber-securities p. 5 "a qualified" investor).

Claim 15. analyzed as in claim 12.

Claim 17. analyzed as in claim 13.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

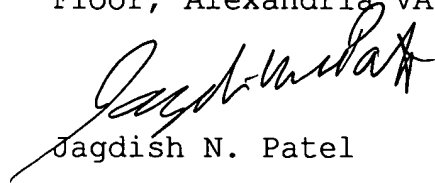
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address



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for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup>  
Floor, Alexandria VA 22202.

A handwritten signature in black ink, appearing to read "Jagdish N. Patel", is written over the printed name.

Jagdish N. Patel

(Examiner, AU 3624)

01/22/04